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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,082	11/13/2006	Kauko Janka	43289-224706	2875
26694	7590	12/23/2009		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			12/23/2009 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/554,082

**Applicant(s)**

JANKA ET AL.

**Examiner**

John Hoffmann

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) 21-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS-08)  
Paper No(s)/Mail Date 10/21/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group 1, claims 12-20 in the reply filed on 10/20/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 21-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/20/2009.

### ***Oath/Declaration***

The declaration(s) is/are defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It fails to identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial. And/or state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Examiner notes the present application actually has 4 different declarations (each of two pages). It appears that the Janaka declare that he is the sole inventor. The other three declarations suggest they are sole inventors (because there is only one

name listed below). But they also indicate that they are second inventors - i.e. no third and fourth inventors.

### ***Claim Objections***

Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 18 depends from claim 1, which has been cancelled. Thus claim 18 depends from a non-existent claim and does not further limit the subject matter of a previous claim. Claim 18 is not further treated on its merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-17 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12: lines 6-7, there is no antecedent basis for "the charge from the first material". There is no step that requires removing the charge from the first material, thus it is unclear whether it is ever actually "from" the first material. Also at lines 6-7, there is no antecedent basis for "the first material on the inner surface" - there is no step of actually depositing the first material. There is also no antecedent basis for the line 12 "the charged second material on the inner surface."

Claim 13: there is no antecedent basis for "the material layer". Claim 12 does not require any material layer. Although the preamble of claim 12 refers to a one or more layers, such does not breathe life and meaning to the claim. The body does not require any layer, and the use of "for" in line 1 of claim 12 indicates an intended result of the method. The same applies to claim 14.

Claims 15-17 do not make sense because they require that materials are guided to the tube and from the tube. If the gas comes from the tube, then it is not guided to the tube – because it originated at the tube. It is already there. It is unclear if the claim intends to recite that the material is first guided to the tube, and then after that is guided from the tube. And claim 12 already requires guiding the material that is inside the tube.

### ***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 12-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida 60033342.

Claim 12: it is clear that the method is for making one or several material layers - for example see figure 36, layers 107A and 107B. They are made in a reaction vessel although not disclosed as being a tube; figure 2 suggests it is long and hollow - not unlike a tube. It would have been obvious to make the reaction vessel in the shape of a tube – such as a tube of rectangular cross-section, depending up the length of the preform 1A one desires to make. It is generally not invention to make a reaction vessel more tube-like than box-like.

**From MPEP 2144.04**

B. Changes in Shape

In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

The reaction vessel (tube) is clearly used in the manufacture of an optical fiber preform (see TITLE).

As to the required "one or several sequences": Examiner notes that applicant identifies two sequences in the paragraph spanning pages 3-4 of the specification. A charge sequence and the collection sequence. The charge sequence corresponds to the first two arranging steps and the first guiding step. The collection sequence corresponds to the third arranging step, the second guiding step, and the bringing step. That is, all of the steps listed in claim 12 are disclosed as being of two distinct sequences, yet claim 12 only requires one sequence.

However there is no requirement that the claim sequence be either of the disclosed sequences. The claim merely requires any sequence that comes from the list of steps. Thus the first arranging step and the first guiding step together are a sequence that comes from the list of steps of claim 12.

More than that, Examiner finds that the broadest reasonable interpretation of "one or several sequences of the following" means any combination of at least two of the following that occur in sequence (i.e. not simultaneously) – they need not be of the order recited in the claim.

Thus Ishida "arranges an electrical charge in a first material" 43, and then (eventually) there is a "finishing" of the guiding of the first material inside the basic tube. Thus Ishida has a sequence of two of the eight steps mentioned in claim 12.

Claim 13: It is clear from figure 23 that Ishida's material 43 comprises argon – which applicant discloses to be a carrier gas (specification, page 9, lines 1-2). As to the limitation regarding the second material: as indicated above, claim 12 requires "one or several sequences" but does not require all of the steps listed in the claim or all of the materials mentioned in the claim. The sequence of the two steps listed above does not use a second material.

Examiner interprets claim 13 as requires that the first material comprises carrier gas – if there is a first material, and the second material comprises particulate constructional material - if there is a second material. Since Ishida does not have the second material, the limitation which further limits the second material fails to define over Ishida.

To put it in other words: since not all the steps are required, the steps are optional (as long as there is at least one sequence). Any further limitation (that further limits an optional feature) is itself not required.

Claim 14: as with claim 13 feature 41 has particulate constructional material (soot). And the limitation regarding the second material does not define over Ishida, because Ishida does not have the second material.



Claims 15-17: As per col. 18, lines 19-21 (and elsewhere)- Ishida discloses that the burners traverse the preform. That is it goes from end-to-end of the tube - if one is making a long preform and has a long reaction chamber that can be considered to be a 'basic tube'. Thus, when the burner 61 (figure 23 of Ishida) is at one end of the tube, reactor it creating soot that essentially comes "from" and end of the tube. And it is guided "to" the tube – that is, the soot is guided towards the inner surface of the tube even though it never actually reached the tube. As discussed above the limitation related to the second material do not define over Ishida, because the broad claim language of claim 12 renders such optional.

Claims 19 and 20 are met because they effectively are the same as claims 15-17 - except that they set forth other requirements for the optional second material. But since Ishida does not have the second material, the claims do not define over Ishida.

Examiner notes these claims do not indicate whether they refer to new guiding steps, of they further limit the guiding steps of claim 12. It is also noted that claims 15-17 do not recite "guiding" the materials - as compared to the -ing form verbs used in claim 12. Because of the difference in active vs. passive voice - it appears that applicant intends that such can have different scopes in their interpretations. Also, as pointed out above, these claims do not make much sense because the it requires the

materials are guided to the tube from the tube - but if they are "from" the tube they are already at the tube, and thus cannot get "to" the tube.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ramsey, Kawabe, Komura, Fletcher and Lucas are cited as being related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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